

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Offic

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APPLICATION NO.	FILING DATE	FIRST NAMED	INVENTOR		ATTORNEY DOCKET NO.
09/036,724	03/06/98	FERRONE		S	FER-1
— HM12/0611 IMCLONE SYSTEMS INCORPORATED			٦.	EYLER, Y	
THOMAS C GAI	LLAGHER			ART UNIT	PAPER NUMBER
7TH FLOOR				1642	5
NEW YORK NY	TABTM			DATE MAILED:	06/11/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



Office Action Summary

Application No. 09/036,724 Applicant(s)

Ferrone et al.

Examiner

Group Art Unit

·	Yvonne Eyler	1642	
Responsive to communication(s) filed on			·
☐ This action is FINAL .			
Since this application is in condition for allowance except in accordance with the practice under Ex parte Quayle,	ot for formal matters, prosecution 1935 C.D. 11; 453 O.G. 213.	n as to the me	erits is closed
A shortened statutory period for response to this action is a longer, from the mailing date of this communication. Fai application to become abandoned. (35 U.S.C. § 133). Ext. 37 CFR 1.136(a).	lure to respond within the period	for response	will cause the
Disposition of Claims			
	is/are p	ending in the	application.
Of the above, claim(s)	is/are wi	thdrawn from	consideration.
Claim(s)			
Claim(s)			
Claim(s)			to.
☐ See the attached Notice of Draftsperson's Patent Draftsperson's	er. ority under 35 U.S.C. § 119(a)-(a) ies of the priority documents have been been been been been been been be	ve been	
*Certified copies not received: Acknowledgement is made of a claim for domestic).	•
Attachment(s) Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Page Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-152	per No(s).		
SEE OFFICE ACTION	ON THE FOLLOWING PAGES		

Application/Control Number: 09/036724

Art Unit: 1642

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:



Claims 1-30, 56, drawn to methods of inhibiting angiogenic conditions, classified in class 514, subclass 2, 12, 44 and class 424, subclass 131.1.

- II. Claims 31-41, 44, 51, 53-55, drawn to immunogens, classified in class 424, subclass 184.1.
- III. Claims 42,43 drawn to antibody producing cells, classified in class 435, subclass 326.
- IV. Claims 45-47, 52, drawn to nucleic acids encoding antibody variable domains, classified in class 536, subclass 23.5.
- V. Claims 48-50, drawn to chimeric antibodies, classified in class 530, subclass 387.3.
- 2. The inventions are distinct, each from the other because of the following reasons:
- 3. The inventions of Groups II, III, IV, and V are all drawn to completely different products. The immunogenic compositions of Group II differ from the compounds of Groups III, IV, and V in both structure and in biological function and use. The considerations and searches required for each composition or compound are different and non-cohesive.
- 4. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

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§ 806.05(h)). In the instant case, the immunogens may be used to generate antibodies for mass

production.

5. Because these inventions are distinct for the reasons given above and have acquired a

separate status in the art as shown by their different classification, restriction for examination

purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required

for any single Group is not required for any other Group, restriction for examination purposes as

indicated is proper.

7. Should Groups I or II be elected, This application contains claims directed to the

following patentably distinct species of the claimed invention:

a. immunogens comprised of antigens which are native

b. immunogens comprised of antigens which are non-native

Each of these species are distinct, having different structural and function considerations and

requiring different searches.

In addition, should species a be elected, the application further contains claims directed to

the following patentably distinct species of the claimed invention:

1) proteins

2) antigen presenting cells

3) antibodies

4) nucleic acids

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Each of these species is distinct having different structural and functional considerations and requiring non-cohesive searches.

In addition, no matter which species 1-4 is chosen, the claims are still further directed to the following patentably distinct species of claimed invention:

- I) FLK-1
- ii) KDR
- iii) FLT-1
- iv) VEGF
- v) Vascular endothelial Cadherin
- vi) Tie
- vii) Tie-2/Tek
- viii) integrins
- ix) bFGF
- x) vitronectin

Each of these species has a different function and different structures not shared with any of the other species. The considerations and searches for each individual species are unique and not shared by any other species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

c. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne Eyler, Ph.D. whose telephone number is (703) 308-6564. The examiner can normally be reached on Monday through Friday from 830am to 630pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 305-3014 or (703) 308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be

 $addressed\ to\ [\textbf{paula.hutzell@uspto.gov}].$

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Yvonne Eyler Patent Examiner

Yvonne Eyler, Ph.D. Patent Examiner

June 8, 1999